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REMARKS

Claims 17-31 are in the case. The Examiner has acknowledged that claims 17-31 have been elected for examination in the Election filed on March 25, 2005. Claims 1-16 and 32-59 have been withdrawn. As shown below, the case is in condition for allowance.

Claim 23 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. As amended above, claim 23 now recites the phrase "a caller" instead of "said caller". Claim 23 also stands objected to under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting "said external service" without providing antecedent basis for the phrase. In Applicants' previous Response to the Office Action Dated September 3, 2003, filed on December 2, 2003, Applicants corrected this typographical error by changing "said external service" to "said external server" and there is antecedent basis for this phrase. In an effort to move the case forward, Applicants again amend claim 23 to correct this typographical error. Claim 23 as amended now has antecedent basis, is patentable, and should be allowed.

Claims 17-30 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster *et al* (U.S. Patent No. 6,804,224) in view of Vishik *et al* (U.S. Patent No. 6,735,287). Claim 31 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Vishik in view of Schuster. As will be shown, Shuster or Vishik, alone or in combination, do not teach each and every element of claims 17-31. Claims 17-31 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 17-31.

Election of Claims Without Traverse

The Office Action of May 4, 2005, acknowledges the election of claims 17-31 for examination, but requests clarification as to whether the election was with or without traverse. Applicants elect claims 17-31 without traverse.

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Claim Rejections - 35 U.S.C. § 103

Claims 17-31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over combinations of Schuster *et al.* (U.S. Patent No. 6,804,224) and Vishik, *et al.* (U.S. Patent No. 6,735,287). Applicants respectfully traverse each rejection. To establish a prima facie case of obviousness, three basic criteria must be met. Manual of Patent Examining Procedure § 2142. The first element required to establish a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a suggestion or motivation to combine the references. *In re Vaack*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The second element required to establish a prima facie case of obviousness under 35 U.S.C. § 103 is that there must be a reasonable expectation of success in the proposed combination of the references. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The third element required to establish a prima facie case of obviousness under 35 U.S.C. § 103 is that the proposed combination of the references must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

The Combination Of Schuster and Vishik
Does Not Teach All Of Applicants' Claim Limitations

The Office Action at page 3 admits that Schuster does not teach all of the limitations of independent claims 17 and 24. Office Action Dated May 4, 2005, paragraph 1, page 3. The Office Action also admits that Vishik does not teach all of the limitations of independent claim 31. Office Action dated May 4, 2005, paragraph 1, page 7. The proposed combinations of the two references do not contain all of the elements of the claims. Applicants first demonstrate the references that do not disclose the elements for which they are cited. Applicants then demonstrate the elements of the claims not addressed by the proposed combinations of Schuster and Vishik.

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References Do Not Disclose The Elements For Which They Are Cited

The Office Action states that Schuster, at column 4, lines 47-53 and column 9, lines 1-5, discloses "a method for specifying telephone services for a particular callee or User A, comprising detecting a call receipt condition to a destination device (User A; Figure 2, 20a) at a trusted telephone network (telephone network with minimal security)."

Applicants respectfully note in response, however, that what Schuster at column 4, lines 47-53 and column 9, lines 1-5, in fact discloses is "a system for providing telephony services," which includes "a PSTN system of trunk lines, a data network, telecommunications devices, local exchanges, gateways, and service provider hosts."

The system for providing telephony services of Schuster does not disclose a method for specifying telephone services for a particular callee, comprising detecting a call receipt condition from a destination device as claimed in the present application. In fact, the Office Action later actually admits that Schuster does not disclose detecting a call receipt condition from a destination device. Office Action Dated May 4, 2005, page 3, paragraph 2. Schuster also does not disclose a trusted telephone network as claimed in claim 17 of the present application.

The Office Action states that Schuster, at column 5, lines 19-45, discloses a method comprising "brokering a connection between said destination device and an external server or telephone service database (Figure 1, 60), enabled to perform a callee identification authentication service." Applicants respectfully note in response, however, that what Schuster, at column 5, lines 19-45, in fact discloses is a system of telephone connections, wherein "[a] data network is used to connect a caller and a callee between access points, such as gateways that connect the PSTN to the data network. Telephone service is provided by the data network service provider using at least one service provider host. The service provider hosts include a telephone service database... The telephone service database may include account information for each user served by the host. The data service provider may provide an access site having a data entry form to enable a user to enter information relating to telephony features to which the user may wish to subscribe, and billing information." Schuster teaches a system of telephone

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connections which converts a voice telephone signal into data packets for transmission using a network service provider, in order to provide a way for users of PSTN telephones to use PBX features without having to be connected to a special private branch exchange system. Schuster, column 4, lines 54-64; column 7, lines 13-26; column 3, lines 30-43; Abstract. Furthermore, the incidental callee identification of Schuster takes place in the PSTN system prior to the sending of any information using the network service provider Schuster, column 5, lines 19-45; Abstract. Such a system, as disclosed in Schuster, does not teach an external server enabled to perform a callee identity authentication service. Schuster does not disclose brokering a connection between said destination device and an external server enabled to perform a callee identity authentication service as claimed in the present application.

The Office Action states that Vishik discloses "a method for specifying telephone services for a particular callee or user, represented in Figure 1, 10 (wherein the user is a called party)." Applicants respectfully note in response, however, that what Vishik at Fig. 1, 10, in fact discloses is "a user," without any notation as to specifying telephone services for a particular callee. In contrast to the present application, Vishik at column 2, lines 45 - 47, discloses "a multiplicity of users of the telecommunication network whose presence information is compiled and made available using the Web service." Respectfully, Applicants further note that what Vishik at column 4, lines 21-23, discloses is a method for "identifying whether a given user is available to receive a communication." Identifying whether a given user is available to receive a communication using a compilation of presence information from a multiplicity of users of Vishik does not disclose specifying telephone services for a particular callee, as claimed in the present application.

With regards to claim 31, the Office Action states that Vishik discloses "a computer program product inherently for specifying telephone services for a particular callee or user, represented in Figure 1, 10 (wherein the user is a called party)." Applicants respectfully note in response, however, that what Vishik at Fig. 1, 10, in fact discloses is "a user," without any notation as to specifying telephone services for a particular callee.

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In contrast to the present application, Vishik at column 2, lines 45 – 47, discloses “a multiplicity of users of the telecommunication network whose presence information is compiled and made available using the Web service.” Respectfully, Applicants further note that what Vishik at column 4, lines 21-23, discloses is a computer program product for “identifying whether a given user is available to receive a communication.” Vishik does not disclose a computer program product for specifying telephone services for a particular callee, as claimed in the present application.

The Office Action states that Vishik discloses “a trusted telephone network (telephone network with minimal security).” Applicants respectfully note in response, however, that what Vishik at column 2, line 28, in fact discloses is “a telephone network.” The telephone network of Vishik does not disclose a trusted telephone network as claimed in the present application. In fact, Vishik does not even mention trusted telephone networks.

The Office Action states that Vishik at column 2, lines 8 – 23; column 3, lines 20 – 50; column 3, line 66 – column 4, line 30; column 5, line 3 – 25; and column 5, line 66 – column 6, line 5; and in the Abstract discloses “means, from said external server or Web service (represented in Figure 1, 32) to determine where services should be routed, for specifying services available to said callee according to an authenticated callee identity received from said presence device.” Applicants respectfully note in response, however, that what Vishik in fact discloses in the cited material is a routing system which determines where messages should be routed. The routing system of Vishik does not disclose “means, recorded on said recording medium, for specifying services available to said callee according to an authenticated callee identity received from said external server.”

The Office Action states that Vishik discloses “means, recorded on said recording medium, for specifying a presence available to said callee according to an authenticated callee identity received from said presence device.” Applicants respectfully note in response, however, that what Vishik at column 4, lines 45 – 54, in fact discloses is a

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system wherein "[o]ne or more signals associated with the ... presence confirmation are communicated from the communications device to the Web service." The presence is made available, not to the callee, but instead to a Web service. Further, because the user's presence is his availability, the phrase "specifying a presence available to said callee" does not make sense. In any case, the means for making a presence of a callee available to a Web service of Vishik does not disclose "means, recorded on said recording medium, for specifying services available to said callee according to an authenticated callee identity received from said external server" claimed in the present application.

The Office Action Does Not Even Mention
Many Of The Elements Of The Applicants' Claims

Applicants point out with respect that the Office Action cannot establish a *prima facie* case for obviousness by combining Schuster and Vishik because Schuster and Vishik do not even mention many of the elements of the Applicants' claims. As stated in *In re Royka*, the proposed combination of the references must teach or suggest all of Applicants' claim limitations to establish a *prima facie* case of obviousness under 35 U.S.C. § 103. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). If a claim element of an applicant's invention is not even mentioned, the claim element is not taught or suggested. Because the combination of Schuster and Vishik does not mention all of Applicants' claim elements, the proposed combination does not teach or suggest all of Applicants' claim limitations. Because the proposed combination does not teach or suggest all of Applicant's claim limitations, the Office Action cannot establish a *prima facie* case for obviousness by combining Schuster and Vishik.

The Office Action states that Vishik discloses at column 3, line 66 – column 4, line 30, a method "wherein the communication device receives a phone call and the user is a called party on a wireline phone enabled to perform a callee identity authentication service via a presence device." Applicants respectfully note in response, however, that the Office Action does not mention, with relation to Vishik, brokering a connection between said destination device and an external server enabled to perform a callee identity

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authentication service. This reference does not disclose the element of claim 17:
“brokering a connection between said destination device and an external server enabled to perform a callee identity authentication service.”

The Office Action states that Vishik at column 2, lines 8 – 23; column 3, lines 20 – 50; column 3, line 66 – column 4, line 30; column 5, line 3 – 25; and column 5, line 66 – column 6, line 5; and in the Abstract discloses the above method further comprising:
“responsive to receiving, from said presence device, an authenticated callee identity of a callee utilizing said destination device (represented in Figure 1, 32), brokering a connection between said destination device and an external server or Web service; [and] specifying services available to said callee according to an authenticated callee identity received from said presence device.” Applicants respectfully note in response, however, the Office Action does not mention, with relation to Vishik, “responsive to receiving, from said external server, an authenticated callee identity of a callee utilizing said destination device, specifying services available to said callee according to said authenticated callee identity.” This element of claim 17 is not disclosed. Because neither reference Action has mentioned the above elements of claim 17, the combination of Vishik and Schuster does not disclose all of the elements of claim 17 of the present application.

Rejected claim 17 contains the following elements and limitations:

- A method for specifying telephone services for a particular callee, comprising:
- detecting a call receipt condition from a destination device at a trusted telephone network;
- brokering a connection between said destination device and an external server enabled to perform a callee identity authentication service; and

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- responsive to receiving from said external server, an authenticated callee identity of a callee utilizing said destination device, specifying services available to said callee according to said authenticated callee identity.

Of these elements and limitations of claim 17, the following two are not mentioned, with relation to Vishik, in the Office Action:

- brokering a connection between said destination device and an external server enabled to perform a callee identity authentication service; and
- responsive to receiving from said external server, an authenticated callee identity of a callee utilizing said destination device, specifying services available to said callee according to said authenticated callee identity.

Though the Office Action rejects claim 17 as obvious based on the combination of Schuster and Vishik, the combination does not disclose the entirety of the elements of claim 17 of the present application needed to support the rejection under 35 U.S.C. § 103(a). Unless the Office Action can cite to a proposed combination of references that teaches or suggests all of the elements and limitation in an applicant's claim, the Office Action does not establish a *prima facie* case for obviousness under 35 U.S.C. § 103(a). Because the proposed combination of Schuster and Vishik does not even mention all of the elements and limitations of claim 17 of the present application, the Office Action does not establish a *prima facie* case of obviousness with regard to claim 17 under 35 U.S.C. § 103(a). Applicants respectfully request the rejection of claim 17 be withdrawn, and claim 17 be allowed.

No Suggestion or Motivation to Combine Schuster and Vishik

To establish a *prima facie* case of obviousness, there must be a suggestion or motivation to combine Schuster and Vishik. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The suggestion or motivation to combine Schuster and Vishik must

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come from the teaching of either Schuster or Vishik themselves, and the Examiner must explicitly point to the teaching within Schuster and Vishik suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman*, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989).

The Office Action states no rationale for motivation to combine Schuster and Vishik for claim 17, other than an assertion at page 3, which states:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Schuster to include detecting a call receipt condition from a destination device as taught by Vishik...."

and on page 7, which states:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Vishik to include an external server enabled to perform a callee identity authentication service as taught by Schuster from a destination device as taught by Vishik...."

In support of the first assertion that combining Schuster and Vishik would have been obvious to one skilled in the art, the Examiner only states that "one of ordinary skill in the art would have been lead to make such a modification since a callee identity is authenticated when an incoming call is placed to a destination device and the call is established between a calling party and the called party...." In support of the second assertion that combining Schuster and Vishik would have been obvious to one skilled in the art, the Examiner only states that "one of ordinary skill in the art would have been

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lead to make such a modification since callee authentication occurs external to the trusted telephone network.” Both assertions fail to explicitly point to the teaching within Schuster and Vishik suggesting the proposed combination. Without more, the rejection is impermissible based on hindsight occasioned by Applicants’ own teaching to reject the claims.

Further, there is no suggestion or motivation to combine Schuster and Vishik because both references lack the same claim elements. That is, neither reference teaches, for example, the claim element of claim 17 “brokering a connection between said destination device and an external server enabled to perform a callee identity authentication service” or the claim element of claim 31 “means, recorded on said recording medium, for brokering a connection between said destination device and an external server enabled to perform a callee identity authentication service” There is no suggestion or motivation to combine the references, because the resultant combination still lacks elements of claims 17 and 31. The suggestion or motivation to combine Schuster and Vishik must come from the teaching of either Schuster or Vishik themselves. Since the resultant combination of Schuster and Vishik still does not disclose all the limitations of claims 17 and 31, the suggestion or motivation to combine Schuster and Vishik does not come from the teaching of Schuster or Vishik. Thus, because Schuster and Vishik do not provide the suggestion or motivation for the proposed combination, the proposed combination cannot support a prima facie case of obviousness.

No Reasonable Expectation of Success in the
Proposed Combination of Schuster and Vishik

To establish a prima facie case of obviousness, there must be a reasonable expectation of success in the proposed combination of Schuster and Vishik. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The teachings of Schuster and Vishik are not sufficient to render the claims prima facie obvious if the proposed combination of Schuster and Vishik is inoperable. *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349 (CCPA 1959). Schuster’s system of telephone connections converts a voice

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telephone signal into data packets for transmission in order to provide a way for users of PSTN telephones to use PBX features. Schuster, column 4, lines 54-64; column 7, lines 13-26; column 3, lines 30-43; Abstract. Vishik's system determines where to route messages to devices, as disclosed, non-PSTN devices, based user presence. Vishik, column 2, lines 8 – 23; column 3, lines 20 – 50; column 3, line 66 – column 4, line 30; column 5, line 3 – 25; and column 5, line 66 – column 6, line 5. The PSTN based system of Schuster will not work to route messages to the non-PSTN devices of Vishik. The combination of Schuster and Vishik therefore cannot establish a prima facie case of obviousness under 35 U.S.C. § 103.

Relations Among Claims

Independent claim 17 claims method aspects of intermediary device based callee identification according to embodiments of the present invention. Claim 17 is allowable for the reasons set forth above. Independent claim 31 claims computer program product aspects of intermediary device based callee identification according to embodiments of the present invention. Claim 31 is allowable for the reasons set forth above. The rejections of claims 17 and 31 therefore should be withdrawn, and claims 17 and 31 should be allowed.

Claims 18-30 depend from independent claim 17. Each dependent claim includes all of the limitations of the independent claim from which it depends. Because the combination of Schuster and Vishik does not disclose or suggest each and every element of the independent claims and no other references refer to the elements of the independent claims, no proposed combination of references can possibly disclose or suggest each and every element of any dependent claim. The rejections of Claims 18-30 therefore should be withdrawn, and these claims also should be allowed.

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Conclusion

Claim 23 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claim 23 also stands objected to under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting "said external service" without providing antecedent basis for the phrase. As amended above, claim 23 now recites the phrase "a caller" instead of "said caller" and recites "said external server" instead of "said external service." Claim 23 as amended now has antecedent basis, is patentable, and should be allowed. Applicants traverse this rejection and request reconsideration of claim 23.

Claims 17-31 stand rejected under 35 U.S.C § 103(a) as unpatentable over combinations of Schuster *et al* (U.S. Patent No. 6,804,224) in view of Vishik *et al* (U.S. Patent No. 6,735,287). None of the references, either alone or in combination, teaches or suggests a method, system, or computer program product for intermediary device based callee identification as claimed in the present application. Claims 17-31 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually and request reconsideration of claims 17-31.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: August 4, 2005By: 

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